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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,076	12/31/2001	David Kaufman	KCC4803 (K-C No. 16,436)	9166

321 7590 09/26/2003

SENNIGER POWERS LEAVITT AND ROEDEL  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102

EXAMINER

RHODE JR, ROBERT E

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/039,076

Applicant(s)

KAUFMAN ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24 - 27, 33, 39 and 41 - 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24 - 27, 33, 39 and 41 - 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/26/2003 has been entered.

### ***Response to Amendment***

The office action of 03/27/2003 rejected claims 1, 2, 5, - 7, 10 - 13, 15 - 21, 23 - 29 and 31 - 40 as unpatentable over the combination of Direct Marketing and Froseth. Claims 3, 9, 14 and 22 were rejected as unpatentable over the combination of Direct Marketing and Froseth in view of Wilmott and claims 4, 8, and 30 were rejected as unpatentable over the combination of Direct Marketing and Froseth and further in view of Phillips.

Applicant amendment of 08/26/2003 amended claim 33 and added new claims 41 - 44 as well as canceled claims 1 - 23, 28 - 32, 34 - 38 and 40. In addition, the applicant traversed rejections of Claims 1 - 40.

Currently, claims 24 - 27, 33, 39 and 41 - 44 are pending.

***Response to Arguments***

Applicant's arguments filed 8/26/2003 have been fully considered but they are not persuasive.

O Applicant argues that the references including Direct Marketing, Forseth and Wilmott are in unrelated fields and therefore they are non-analogous art and it would not be obvious to combine. On the other hand, the applicant does note that these references do address "customizing" a product such as cereal and cosmetics. Moreover, the applicant argues that these references – since they are mere and unrelated aggregation of references based on non-analogous art in customizing of unrelated products (i.e. not facial tissue or absorbent paper) and therefore is a textbook example of impermissible hindsight analysis.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore in this case, the cited references in the previous as well as the current rejection were in the same field of online shopping for consumer personal products and they included the capability to select several features for customization purposes - such as color and scent by the shopper. As importantly, the ability to shop online and customize a product by selecting several features was old and well known at the time of the applicant's invention as well as the ability to manufacture, package and deliver the customized product and package for the shopper.

In response to applicant's argument that the cited references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, these references cited in the previous rejection as well as the current rejection were in the same field of online shopping for personal consumer

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products and they fully address the customizing of a *product* – for a consumer. Moreover, the applicant is applying for a patent to customize such *products* as absorbent paper products/custom facial tissue as well as customize packaging of that product(s). In that regard and for examination purposes, the kind or type of *product* that one is customizing is given little patentable weight. The kind or type of *product* is given little patentable weight because the claim language limitation such as “*custom facial tissue and/or absorbent paper products*” is considered to be non-functional descriptive material, which does not patentably distinguish the applicant’s invention from the cited references in this and the previous rejection. Thereby, the non-fictional descriptive material is directed only to the type/kind of *product* (i.e. absorbent paper) and does not affect either the structure or method/process, which leaves the method and system unchanged.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In Claim 33, the claimed invention is directed to non-statutory subject matter. The claim is directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. See *In re Johnston*, 183 USPQ 172 (CCPA 1974) and *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d 1452.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 24 – 27, 39, 41 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Who Wants to Market a Millionaire?”; Rosenspan, Alan; Direct Marketing; March 2001; page 45 (hereafter referred to as Direct Marketing) in view of Froseth (US Patent Application Publication 2002/0004749A).**

Regarding claim 24 and related claims 41 and 44, Direct Marketing discloses and teaches a method and system in which a manufacture produces a custom facial tissue product for a consumer (Page 2, lines 42 – 44).

However, Direct Marketing does not specifically disclose and teach the method and system comprising the manufacturer – receiving information from the consumer via a communications network, said information relating to a first option of a first plurality of options of a first feature of the custom facial tissue product and relating to a second option of a second plurality of options of a second feature of the custom facial tissue product wherein the second option is different from the first option and wherein the second feature different from the first Feature (see at least Abstract, Page 1, PARA 0011, 0012, Page 2, PARA 0015 and Figures 1, 2A, 3A, 3D, 4A, 5, and 9); providing

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said information to a production machine to the communication network and configured to receive the information provided by the consumer via the for a first of a first plurality of options of a first feature of the facial tissue product and relating to a second option of a linked communications network, said production machine configured to produce custom facial tissue products including any one of the first plurality of options of the first feature and including any one of the second plurality of options of the second feature (see at least Abstract, Page 6, PARA 0086 and Figure 1); and producing by the production machine the custom facial tissue product as desired by the consumer and in accordance with the information received from the consumer such that the produced custom facial tissue product includes the first option and the second option (see at least Page 10, PARA 0116 and Figures 1 and 3A). Moreover:

regarding Claim 25, Froseth teaches a method wherein the communications network is a computer network, and wherein receiving includes receiving said information from the consumer over the computer network via a computer server (see at least Page 6, PARA 0086 and Figures 1 and 2A).

regarding Claim 26, Froseth teaches a method wherein the communications network is a telephony network, and wherein receiving includes receiving said information from the consumer over the telephony network via a telephone attendant (Page 6 and 7, PARA 0086) and (27) wherein said telephone attendant is an automated attendant (Page 6 and 7, PARA 0086).



Regarding Claim 39, Froseth teaches a method wherein the first feature is selected from product count, product style, product color (Page 5, PARA 0075 and Page 11, PARA 0130), product scent and product graphic design and wherein the second feature is selected from product packaging style (Page 2, PARA 0016), product packaging color and product packaging graphic design (Page 7, PARA 0093 and Figure 16).

It would have been obvious to one of ordinary skill in that art at the time of the invention to have provided the method of Direst Marketing with the method of Froseth to have enabled method and system in which a manufacturer produces a custom facial tissue product for a consumer, the method and system comprising the manufacturer – receiving information from the consumer via a communications network, said information relating to a first option of a first plurality of options of a first feature of the custom facial tissue product and relating to a second option of a second plurality of options of a second feature of the custom facial tissue product wherein the second option is different from the first option and wherein the second feature different from the first Feature; providing said information to a production machine to the communication network and configured to receive the information provided by the consumer via the for a first of a first plurality of options of a first feature of the facial tissue product and relating to a second option of a linked communications network, said production machine configured to produce custom facial tissue products including any one of the first plurality of options of the first feature and including any one of the second plurality

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of options of the second feature; and producing by the production machine the custom facial tissue product as desired by the consumer and in accordance with the information received from the consumer such that the produced custom facial tissue product includes the first option and the second option. In that regard, the consumer will have a method and system that provides an online site which incorporates all facets of a transaction for selecting, purchasing, producing and delivery of an absorbent paper product from their home and thereby allow the consumer all these functions without leaving their home – saving the consumer time and cost associated with on site shopping at a store or mall, which will increase the probability that they will be more satisfied as well increasing the probability that they will shop at the site in the future.

**Claim 33 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over the combination of Direct Marketing and Froseth and further in view of Schilling (US Patent Application Publication 2003/0035138 A1).**

Regarding Claim 33, the combination of Direct Marketing and Froseth discloses and teaches substantial the applicant's invention including a method in which a supplier customizes packaging for an absorbent paper product for a consumer (see at least Page 26, PARA 0272, 0273 and Figures 1, 16 and 23A-C of Froseth) as well as providing the custom absorbent paper product having the packaging including the selected product design (see at least Figures 1, 16 and 23A-C of Froseth) as well as a purchase order (Page 13, PARA 0140 of Froseth).

However, the combination of Direct Marketing and Froseth does not specifically disclose and teach receiving from the consumer an identification of a selected one of graphic designs for packaging embodying the selected one of the graphic designs. Nor does the combination of Direct Marketing and Froseth specifically disclose and teach incorporating the selected graphic design identified by the consumer into packaging and to thereby produce the product having the packaging including the selected graphic design only to said consumer.

On the other hand, Schilling does disclose and teach receiving from the consumer an identification of a selected one of graphic designs for packaging embodying the selected one of the graphic designs (see at least Abstract, Page 2, PARA 0043 and Figures 9-12) as well as incorporating the selected graphic design identified by the consumer into packaging and to thereby produce the product having the packaging including the selected graphic design only to said consumer (see at least Abstract, Page 1, PARA 0003 and 0005).

It would have been obvious to have provided the combination of Direct Marketing and Froseth with the method of Schilling to have enabled receiving from the consumer an identification of a selected one of graphic designs for packaging embodying the selected one of the graphic designs as well as incorporating the selected graphic design identified by the consumer into packaging and to thereby produce the product having

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the packaging including the selected graphic design only to said consumer – in order to include packaging design and selection. In this manner, the consumer's satisfaction with the site given these additional packaging features will increase their satisfaction. This increased satisfaction will increase the probability that the consumer will return for additional shopping as well as recommend the site to others.

Please note and regarding claim 42, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the method and system of Schilling with the combination of Direct Marketing and Froseth to have provided the printing of selected graphics designs features on the absorbent paper product too. In that regard, it would have enabled a reduction in the total cost of producing the packaged absorbent paper product for the manufacturer and they in turn could lower the price of the total packaged product to the consumer. Thereby, the consumer would be most pleased and increase the probability that they will buy continually from the online site.

**Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Direct Marketing and Froseth and further in view of Wilmott (US Patent Application Publication 2002/0082745).**

The combination of Direct Marketing and Froseth disclose and teach substantially the applicant's invention as recited.

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However, the combination does not specifically disclose and teach a production machine including a fragrancener.

On the other hand, Wilmott teaches a production machine including a fragrancener (see at least Abstract, Page 4, Para 0047 and Figure 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Direct Marketing and Froseth with the method and system of Wilmott to enable the production machine including a fragrancener – in order to provide the consumer with more optional features and additional access places other than the home and thereby increasing their satisfaction as well increasing the probability of additional product sales.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art includes Proctor & Gamble's online beauty business blossoms; CC News; Yardmouth; Jul 2001; Anonymous, which addresses online customization of beauty products for a consumer.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER

  
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